

## REMARKS

### Status Of Application

Claims 42-55 are pending in the application; the status of the claims is as follows:

Claims 42-49 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,737,014 to Tojo et al. (hereinafter the “Tojo patent”).

Claims 42 and 44-49 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,162,833 to Taka (hereinafter the “Taka patent”).

Claim 43 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the Taka patent in view of U.S. Patent No. 5,034,804 to Sasaki et al. (hereinafter the “Sasaki patent”).

Claims 50-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Tojo patent in view of U.S. Patent No. 4,709,385 to Pfeiler et al. (hereinafter the “Pfeiler patent”).

Claims 50-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Taka patent in view of the Pfeiler patent.

### Drawings

Please note that a Request for Approval of Proposed Drawing Changes was filed on January 24, 2001; however, to date Applicants have not received an approval by the Examiner.

### Claim Amendments

Claims 42, 47, 50 and 54 have been amended to provide additional clarity and specificity. These changes are not necessitated by the prior art, are unrelated to the patentability of the invention over the prior art, and do not introduce any new matter.

**35 U.S.C. § 102(e) Rejections**

**Claims 42-49**

The rejection of claims 42-49 under 35 U.S.C. § 102(e) as being anticipated by the Tojo patent, is respectfully traversed based on the following.

The Tojo patent shows an arrangement comprising a memory 7, a disk 20, and a monitor 10. However, in the Tojo patent, the disk 20 is mounted in the disk recorder 2 and is not included inside of imager 1, where memory 7 and monitor 10 are installed.

In contrast to the cited prior art, claim 42 includes:

a first memory, installed inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;

a second memory, installed inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;

a reproduction device, installed inside the camera body, to selectively receive and reproduce image information recorded on one of the first memory and the second memory...

The Tojo patent does not show or suggest a device where the first and second memories are installed inside the camera body. In addition, there is no facility for displaying the information stored in memory 7. To provide anticipation, a reference must show, expressly or inherently, every element of the claim. MPEP §2131. Therefore, the Tojo patent does not anticipated claim 42. Claims 43-46 are dependent on claim 42 and thus include every limitation of claim 42. Therefore, the Tojo patent does not anticipate claims 43-46.

Also in contrast to the cited prior art, claim 47 includes:

a first connection electrically connectable to a first recording medium, mounted inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;

a second connection electrically connectable to a second recording medium, mounted inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;

a reproduction device, installed in the camera body, to selectively reproduce image information stored on one of the first recording medium and the second recording medium...

As noted above, the Tojo patent does not show or suggest a device where the first and second memories are mounted inside the camera body and there is no facility for displaying the information stored in memory 7. To provide anticipation, a reference must show, expressly or inherently, every element of the claim. Therefore, the Tojo patent does not anticipate claim 47. Claims 48 and 49 are dependent on claim 47 and thus include every limitation of claim 47. Therefore, the Tojo patent does not anticipate claims 48 and 49.

Accordingly, it is respectfully requested that the rejection of claims 42-49 under 35 U.S.C. § 102(e) as being anticipated by the Tojo patent, be reconsidered and withdrawn.

**Claims 42 and 44-49**

The rejection of claims 42 and 44-49 under 35 U.S.C. § 102(e) as being anticipated by the Taka patent is respectfully traversed based on the following.

The Taka patent shows an arrangement comprising the recall memory 10, the special memory 12, and the image display device 18. However, it is not clear whether these devices 10, 12 and 18 are installed inside the camera body 20. The Taka patent states at column 3, lines 32-36 that:

FIG. 1 shows in block diagram the arrangement of all devices of a practical example of the still camera equipped with an electronic imaging device, to which the invention is applied. The outer appearance of this camera is partly shown in FIG. 2.

Further, the Taka patent states at column 4, lines 18-20 that a "camera body 20 whose outer appearance is shown in FIG. 2 has display device 18 . . ." In other words,

Taka states that FIG. 1 shows the entirety of the still camera and that FIG. 2 shows the camera body 20, which is a separate element in FIG. 1. Display devices 18 and 26 are shown as part of the camera body 20, but there is no discussion as to which of the other components of FIG. 1 are included. It is not clear whether the recall memory 10 and the special memory 12 are arranged inside or outside of the camera body 20.

In contrast to the cited prior art, claim 42 includes:

- a first memory, installed inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;
- a second memory, installed inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;
- a reproduction device, installed inside the camera body, to selectively receive and reproduce image information recorded on one of the first memory and the second memory...

The Taka patent is indefinite as to the position of the recall memory and the special memory, and thus does not show or suggest a device where the first and second memories are installed inside the camera body. To provide anticipation, a reference must show, expressly or inherently, every element of the claim. Therefore, the Taka patent does not anticipated claim 42. Claims 44-46 are dependent on claim 42 and thus include every limitation of claim 42. Therefore, the Taka patent does not anticipate claims 44-46.

Also in contrast to the cited prior art, claim 47 includes:

- a first connection electrically connectable to a first recording medium, mounted inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;
- a second connection electrically connectable to a second recording medium, mounted inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;
- a reproduction device, installed in the camera body, to selectively reproduce image information stored on one of the first recording medium and the second recording medium...

As noted above, the Taka patent does not show or suggest a device where the first and second memories are mounted inside the camera body. To provide anticipation, a

reference must show, expressly or inherently, every element of the claim. Therefore, the Taka patent does not anticipate claim 47. Claims 48 and 49 are dependent on claim 47 and thus include every limitation of claim 47. Therefore, the Taka patent does not anticipate claims 48 and 49.

Accordingly, it is respectfully requested that the rejection of claims 42 and 44-49 under 35 U.S.C. § 102(e) as being anticipated by the Taka patent, be reconsidered and withdrawn.

**35 U.S.C. § 103(a) Rejections**

**Claim 43**

The rejection of claim 43 under 35 U.S.C. § 103(a), as being unpatentable over the Taka patent in view of the Sasaki patent, is respectfully traversed based on the following.

Claim 43 is dependent upon claim 42 and thus includes every limitation of claim 42. As noted above, with regard to claim 42, the Taka patent is indefinite as to the position of the special memory, and thus does not show or suggest a device where the first and second memories are installed inside the camera body. The Sasaki patent merely shows the use of a single memory 15. Therefore, the Sasaki patent also does not show or suggest a device where the first and second memories are installed inside the camera body. To support a *prima facie* case of obviousness, the combined references must show or suggest every limitation of the claim. MPEP §2143. The Taka and Sasaki patents, even when combined, do not show or suggest every limitation of claim 43. Therefore, the cited references do not provide a *prima facie* case for obviousness of claim 43.

Accordingly, it is respectfully requested that the rejection of claim 43 under 35 U.S.C. § 103(a) as being unpatentable over the Taka patent in view of the Sasaki patent, be reconsidered and withdrawn.

**Claims 50-55**

The rejection of claims 50-55 under 35 U.S.C. § 103(a) as being unpatentable over the Tojo patent in view of the Pfeiler patent, is respectfully traversed based on the following.

The Pfeiler patent shows a system including a third image memory 12. The third image memory 12 is adapted to supply a signal from the differencing unit 11 to the display 14 via the A/D converter 13. Although Pfeiler does not clearly recite the specific function of the differencing unit 11, it is presumed through the specification and the drawings that the differencing unit 11 is adapted to obtain a difference signal between a signal from the first image memory 8 (or from the second image memory 9) and a signal from the A/D converter 6 (*i.e.*, image information that has been photographed by the video camera 5). Thus, neither the information recorded in the third image memory 12 nor the image displayed on the display 14 corresponds to the information stored in the first image memory 8 and the second image memory 9. In other words, the third image memory 12 of the Pfeiler patent is not an element for temporarily storing information that has been stored in the first image memory 8 and the second memory 9 prior to display, but is an element adapted for temporarily storing information that is different from the information stored in the first image memory 8 and the second image memory 9 after that information has been created by the differencing unit.

In contrast to the cited prior art, claim 50 includes:

a first memory capable of storing image information corresponding to at least two photographic frames;  
a second memory;  
a reproduction device to selectively receive and reproduce image information recorded on one of the first memory and the second memory;  
an internal memory for temporarily storing image information; and  
a changer for selectively changing between a first condition, in which image information on the first memory is outputted to the reproduction device, via the internal memory so that the image information recorded on the first memory is reproduced as an image by the reproduction device, and a second condition, in which image information on the second

memory is outputted to the reproduction device via the internal memory so that the image information recorded on the second memory is reproduced as an image by the reproduction device.

The rejection states that "Tojo fails to teach the use of a memory for storing the image signal in order to easily control the timing of the image signal . . ." (Office Action, page 5) As noted above, the Pfeiler patent does not show the use of a memory for temporarily storing the image information, but rather memory 12 is used to store the output of differencing unit 11. Thus, Tojo and Pfeiler patents, even when combined, do not show or suggest every limitation of claim 50. Therefore, the cited references do not provide a *prima facie* case for obviousness of claim 50. Any claim that is dependent on a nonobvious claim is also nonobvious. MPEP §2143.03. Therefore, claims 51-53 are also nonobvious.

Also in contrast to the cited prior art, claim 54 includes:

a first connection electrically connectable to a first recording medium capable of storing image information corresponding to a plurality of photographic frames;

a second connection electrically connectable to a second recording medium;

a reproduction device to selectively reproduce image information stored on one of the first recording medium and the second recording medium;

an internal memory for temporarily storing image information; and

a changer to selectively change between a first condition, in which the reproduction device and the first connection are placed in communication via the internal memory so that the image information recorded on the first recording medium is reproduced as an image by the reproduction device, and a second condition, in which the reproduction device and the second connection are placed in communication via the internal memory so that the image information recorded on the second recording medium is reproduced as an image by the reproduction device.

As noted above, the Tojo fails to teach the use of a memory for storing the image signal and the Pfeiler patent does not show the use of a memory for temporarily storing the image information, but rather memory 12 is used to store the output of differencing unit 11. Thus, the Tojo and Pfeiler patents, even when combined, do not show or suggest

every limitation of claim 54. Therefore, the cited references do not provide a *prima facie* case for obviousness of claim 54. Any claim that is dependent on a nonobvious claim is also nonobvious. Therefore, claim 55 is also nonobvious.

Accordingly, it is respectfully requested that the rejection of claims 50-55 under 35 U.S.C. § 103(a) as being unpatentable over the Tojo patent in view of the Pfeiler patent, be reconsidered and withdrawn.

### **Claims 50-55**

Claims 50-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Taka patent in view of the Pfeiler patent is respectfully traversed based on the following.

In contrast to the cited prior art, claim 50 includes:

a first memory capable of storing image information corresponding to at least two photographic frames;  
a second memory;  
a reproduction device to selectively receive and reproduce image information recorded on one of the first memory and the second memory;  
an internal memory for temporarily storing image information; and  
a changer for selectively changing between a first condition, in which image information on the first memory is outputted to the reproduction device, via the internal memory so that the image information recorded on the first memory is reproduced as an image by the reproduction device, and a second condition, in which image information on the second memory is outputted to the reproduction device via the internal memory so that the image information recorded on the second memory is reproduced as an image by the reproduction device.

The rejection states that "Taka fails to teach the use of a memory for receiving the images from the first or second memory." (Office Action, page 5) As noted above, the Pfeiler patent does not show the use of a memory for temporarily storing the image information, but rather memory 12 is used to store the output of differencing unit 11. Thus, the Taka and Pfeiler patents, even when combined, do not show or suggest every limitation of claim 50. Therefore, the cited references do not provide a *prima facie* case

for obviousness of claim 50. Any claim that is dependent on a nonobvious claim is also nonobvious. Therefore, claims 51-53 are also nonobvious.

Also in contrast to the cited prior art, claim 54 includes:

- a first connection electrically connectable to a first recording medium capable of storing image information corresponding to a plurality of photographic frames;
- a second connection electrically connectable to a second recording medium;
- a reproduction device to selectively reproduce image information stored on one of the first recording medium and the second recording medium;
- an internal memory for temporarily storing image information; and
- a changer to selectively change between a first condition, in which the reproduction device and the first connection are placed in communication via the internal memory so that the image information recorded on the first recording medium is reproduced as an image by the reproduction device, and a second condition, in which the reproduction device and the second connection are placed in communication via the internal memory so that the image information recorded on the second recording medium is reproduced as an image by the reproduction device.

As noted above, the Taka fails to teach the use of a memory for storing the image signal and the Pfeiler patent does not show the use of a memory for temporarily storing the image information, but rather memory 12 is used to store the output of differencing unit 11. Thus, the Taka and Pfeiler patents, even when combined, do not show or suggest every limitation of claim 54. Therefore, the cited references do not provide a *prima facie* case for obviousness of claim 54. Any claim that is dependent on a nonobvious claim is also nonobvious. Therefore, claim 55 is also nonobvious.

Accordingly, it is respectfully requested that the rejection of claims 50-55 under 35 U.S.C. § 103(a) as being unpatentable over the Taka patent in view of the Pfeiler patent, be reconsidered and withdrawn.

**CONCLUSION**

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,

and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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## APPENDIX

### **VERSION WITH MARKINGS TO SHOW CHANGES MADE**

The following is a marked-up version of the changes to the claims which are being made in the attached response to the Office Action dated July 16, 2002.

#### **IN THE CLAIMS:**

42. (Once Amended) A camera comprising:  
a camera body;  
a first memory, installed inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;  
a second memory, installed inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;  
a reproduction device, installed inside the camera body, to selectively receive and reproduce image information recorded on one of the first memory and the second memory; and  
a changer for selectively changing between a first condition, in which image information on the first memory is outputted to the reproduction device, and a second condition, in which image information on the second memory is outputted to the reproduction device.

47. (Once Amended) A camera capable of supporting a first memory and a second memory, the camera comprising:  
a camera body;  
a first connection electrically connectable to a first recording medium, mounted inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;  
a second connection electrically connectable to a second recording medium, mounted inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;

a reproduction device, installed in the camera body, to selectively reproduce image information stored on one of the first recording medium and the second recording medium; and

a changer to selectively change between a first condition, in which the reproduction device and the first connection are placed in communication, and a second condition, in which the reproduction device and the second connection are placed in communication.

50. (Once Amended) A camera comprising:

a camera body;

a first memory capable of storing image information corresponding to at least two photographic frames;

a second memory;

a reproduction device to selectively receive and reproduce image information recorded on one of the first memory and the second memory;

an internal memory for temporarily storing image information; and

a changer for selectively changing between a first condition, in which image information on the first memory is outputted to the reproduction device, via the internal memory so that the image information recorded on the first memory is reproduced as an image by the reproduction device, and a second condition, in which image information on the second memory is outputted to the reproduction device via the internal memory so that the image information recorded on the second memory is reproduced as an image by the reproduction device.

54. (Once Amended) A camera capable of supporting a first memory and a second memory, the camera comprising:

a camera body;

a first connection electrically connectable to a first recording medium capable of storing image information corresponding to a plurality of photographic frames;

a second connection electrically connectable to a second recording medium;

a reproduction device to selectively reproduce image information stored on one of the first recording medium and the second recording medium;

an internal memory for temporarily storing image information; and

a changer to selectively change between a first condition, in which the reproduction device and the first connection are placed in communication via the internal memory so that the image information recorded on the first recording medium is reproduced as an image by the reproduction device, and a second condition, in which the reproduction device and the second connection are placed in communication via the internal memory so that the image information recorded on the second recording medium is reproduced as an image by the reproduction device.